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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,747	07/13/2003	Jay E. Widmar	002905/01/10	3358

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EXAMINER

ESTRADA, ANGEL R

ART UNIT PAPER NUMBER

2831

DATE MAILED: 01/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,747

Applicant(s)

WIDMAN, JAY E.

Examiner

Angel R. Estrada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11/19/02.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other

DETAILED ACTION

Information Disclosure Statement

1. The Examiner has crossed out the Klein reference (US 4,456,784) from the Supplemental IDS because this reference was already mentioned on the previous IDS filed on July 31, 2001.

Claim Objections

2. Claims 15 and 18 are objected to because of the following informalities:

Claim 15 line 3, change "a inner chamber" to --an inner chamber--.

Claim 18 line 2, change "the inside surface" to --the inner surface--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 line 5, "the ends of the conduit" lacks antecedent basis.

Claim 15 line 6, "the ends of the housing", lacks antecedent basis.

Claim 18 line 3, "the shoulder", lacks antecedent basis.

Claim 19 line 1-2, "the sealant compound", lacks antecedent basis.

Claims 16, 17 and 20 are included because of their dependency.

Any further rejections of claims 15-20 in this office action are based on claims 15-20, as they are understood by the examiner.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Larson (US 3,555,171).

Regarding claim 1, Larson discloses an apparatus (see figure 1) comprising: a housing (B) having an inner chamber and an outer surface (see figure 1 and 2); at least one free running hub (G) disposed on, and mounted to, said housing (B); and a flexible membrane (H) disposed within the inner chamber of said housing (see figure 1) adjacent to said at least one free running hub (G).

Note 1: It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re. Hutchison, 69 USPQ 138. Therefore, this limitation "*adapted for coupling to at least one end of the conduit*" has not been given patentable weight

Note 2: It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed

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apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). Therefore, this limitation "*for sealing a conduit*" and "*for coupling to at least one end of the conduit*" has not been given patentable weight

Regarding claim 5, Larson discloses the apparatus (see figure 1), wherein the housing (B) is defined by a mid-section, which is substantially cylindrically shaped (see figure 1), and two free running hub (G) is disposed on, and mounted to, opposite end of the mid-section (see figure 1).

Regarding claim 12, Larson discloses the apparatus (see figure 1) wherein the flexible membrane (H) is a generally disk shaped flexible membrane (see figure 4) formed of neoprene (column 3 line 10-16).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson (US 3,555,171) in view of Cameron (US 5,560,655).

Regarding claim 2, Larson discloses the claim invention except for the apparatus comprising means for purging any air, other gases or moisture, which may be trapped

within the inner chamber of said housing. Cameron teaches a housing for electrical conduits (18, 20) that includes means (11) capable of purging any air, gases or moisture which may be trapped within the inner chamber of said housing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide to Larson's housing with means that can purge any air or moisture trapped within the inner chamber of said housing as taught by Cameron to improve the sealing of the conduit and also to provide means that permits the insertion of insulated materials inside the conduit.

Regarding claim 3, Cameron teaches the purging means (11) comprise a threaded port (40) formed in the housing (12) and a threaded plug (11), which is adapted to mate with said threaded port (see figure 1 and 3).

Regarding claim 4, Cameron teaches the purging means (11) being a spring-loaded ball-type valve (see figure 4).

6. Claims 6-8, 15, 17, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson (US 3,555,171) in view of Hutchison (US 4,301,325).

Regarding claim 6, Larson discloses the claimed invention except for the free running hub having an inside surface, which has a first set female threads (see figure 2) formed thereon for mating with the ends of the conduit. Hutchison teaches an apparatus (see figure 1) for sealing a conduit (2), comprising a free running hub (4) having an inside surface which has a first set female threads (see figure 1) formed thereon for mating with the ends of the conduit (2). It would have been obvious to one

of ordinary skill in the art at the time the invention was made to make Larson's hubs with a first set female threads as taught by Hutchison to provide means to attach a threaded conduit to each the hub to improve the sealing of the conduit and provide protection to the wires (X, Y); by using this modification a threaded conduit must be use to firmly sealed the apparatus, the wire have more protection since now they will be located inside a conduit and the sealing of the apparatus will improve since the conduit can be firmly secured inside the hubs.

Regarding claim 7, Larson discloses the apparatus (see figure 1) wherein the free running hubs (G) has a second set female threads (16) formed thereon for mating with the ends of the cylindrically-shaped mid-section (B) and a shoulder adjacent to the second set of female threads (see figure 2).

Regarding claim 8, Larson discloses the apparatus (see figure 1) wherein flexible membrane (H) disposed on the inside surface of each of the free running hubs (G) adjacent to the shoulder (see figure 5).

Regarding claim 15, Larson discloses an apparatus (see figure 1) for sealing a conduit (X) comprising a housing (B) having an inner chamber and an outer surface (see figure 1 and 2); at least one free running hub (G) having an inner surface and a coupling (see figure 5), wherein the coupling comprises a set of female threads (see figure 2)) formed on said inner surface for mating with the ends of the housing (see figure 2); and a flexible membrane (H) disposed within the inner chamber of said housing (B) adjacent to said at least one free running hub (see figure 2); but Larson lacks a set of female threads formed on said inner surface of the hubs for mating with

the ends of the conduit. Hutchison discloses an apparatus (see figure 1) for sealing a conduit (2) comprising a housing (11) at least one free running hub (4) comprising a first and second set coupling (see figure 1), wherein the first coupling comprises a first set female threads formed on said inner surface for mating the ends of the housing (see figure 1 and 2) and a second set female threads formed on said inner surface for mating with the ends of the conduit (see figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make Larson's hubs with a set of female threads formed as taught by Hutchison to provide means to attach a threaded conduit to each the hub to improve the sealing of the conduit and provide protection to the wires (X, Y); by using this modification a threaded conduit must be use to firmly sealed the apparatus, the wire have more protection since now they will be located inside a conduit and the sealing of the apparatus will improve since the conduit can be firmly secured inside the hubs.

Regarding claim 17, Larson discloses the apparatus (see figure 1), wherein the housing (B) is defined by a mid section, which is substantially cylindrically shaped (see figure 1), and two free running hubs (G) are disposed on, and mounted to opposite ends of the mid-section (see figure 1).

Regarding claim 18, Larson discloses the apparatus (see figure 1) wherein flexible membrane (H) disposed on the inside surface of each of the free running hubs (G).

Regarding claim 20, Larson discloses the apparatus (see figure 1) wherein the flexible membrane (H) is a generally disk shaped flexible membrane (see figure 4)

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formed of neoprene (column 3 line 10-16) and has at least one opening for accommodating one or more cables adjacent to a shoulder (see figure 5).

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larson (US 3,555,171).

Regarding claim 11, Larson discloses the claimed invention except for the housing formed of an aluminum alloy. It would have been obvious to one having ordinary skill in the art at the time the invention was made to formed the housing of an aluminum alloy, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

8. Claims 9, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson (US 3,555,171) in view of Klein (US 4,456,784).

Regarding claim 9, Larson discloses the claimed invention except for said apparatus comprising a polyurethane-based epoxy sealant compound disposed within said inner chamber. Klein discloses an apparatus (19) for sealing a conduit (3), said apparatus comprising a housing having an inner chamber (see figure 3) filled with polyurethane-based epoxy sealant compound (6). It would have been obvious to of ordinary skill in the art at the time the invention was made to fill Larson's body inner chamber with a polyurethane-based epoxy sealant compound as taught by Klein to

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improve the sealing of the conduit by providing a barrier against the flow of vapor through the apparatus.

Regarding claim 10, Klein teaches that said polyurethane-based epoxy sealant compound (6) comprises a polymer and a monomer (column 3 line 9-38).

Regarding claim 13, Larson discloses a method (see figure 1), comprising the steps of coupling said apparatus to at least one end of the conduit (see figure 1); threading any wires or cables (12) contained within said conduit (X) through said flexible membrane (H); but lacks the step of filling the inner chamber with a polyurethane-based epoxy sealant compound. Klein discloses an apparatus (19) for sealing a conduit (3), said apparatus comprising a housing having an inner chamber (see figure 3) filled with polyurethane-based epoxy sealant compound (6). It would have been obvious to of ordinary skill in the art at the time the invention made to fill Larson's body inner chamber with a polyurethane-based epoxy sealant compound as taught by Klein to improve the sealing of the conduit by providing a barrier against the flow of vapor through the apparatus.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larson (US 3,555,171) in view of Klein (US 4,456,784) as applied in claim 13 and further in view of Cameron (US 5,560,655).

Regarding claim 14, the modified Larson discloses the claimed invention except for the step of releasing any air, other gases, or moisture, which may be trapped in the inner chamber after it is filled with the epoxy sealant compound, through a purging

means. Cameron teaches a housing for electrical conduits (18, 20) that includes means (11) for purging any air, gases or moisture, which may be trapped within the inner chamber of said housing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide to the modified Larson's housing with a mean that can purge any air or moisture trapped within the inner chamber of said housing as taught by Cameron to improve the sealing of the conduit and also to provide means that permits the insertion of insulated materials inside the conduit.

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larson (US 3,555,171) in view of Hutchison (US 4,301,325) as applied in claim 15, and further in view of Cameron (US 5,560,655).

Regarding claim 16 the modified Larson discloses the claimed invention except for the step of releasing any air, other gases, or moisture, which may be trapped in the inner chamber after it is filled with the epoxy sealant compound, through a purging means. Cameron teaches a housing for electrical conduits (18, 20) that includes means (11) for purging any air, gases or moisture, which may be trapped within the inner chamber of said housing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide to the modified Larson's housing with a mean that can purge any air or moisture trapped within the inner chamber of said housing as taught by Cameron to improve the sealing of the conduit and also to provide means that permits the insertion of insulated materials inside the conduit.

11. Claims 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Larson (US 3,555,171) in view of Hutchison (US 4,301,325) as applied in claim 15 and further in view of Klein (US 4,456,784).

Regarding claim 19, the modified Larson discloses the claimed invention except for said apparatus comprising a polyurethane-based epoxy sealant compound disposed within said inner chamber. Klein discloses an apparatus (19) for sealing a conduit (3), said apparatus comprising a housing having an inner chamber (see figure 3) filled with polyurethane-based epoxy sealant compound (6). It would have been obvious to of ordinary skill in the art at the time the invention was made to fill Larson's body inner chamber with a polyurethane-based epoxy sealant compound as taught by Klein to improve the sealing of the conduit by providing a barrier against the flow of vapor through the apparatus.

Response to Arguments

12. Applicant's arguments filed November 29, 2002 have been fully considered but they are not persuasive.

In response to the arguments that Larson does not disclose a conduit or hub adapted for coupling to at least one end of the conduit; the examiner points out that these limitation have not been considered because the term "adapted to" is not a positive limitation and it does not constitute a limitation in any patentable sense and the manner in which a claimed apparatus is intended to be employed does not differentiate

the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sharp (US 5,654,526) discloses an apparatus for sealing a conduit comprising a housing having an inner chamber and an outer surface. Brownfield (US 3,871,692) at least one free running hub disposed with first and second female threaded.

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15. Any inquiry concerning this communication should be directed to Angel R. Estrada at telephone number (703) 305-0853. The Examiner can normally be reached on Monday-Friday (8:30 -5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (703) 308-3682. The fax numbers for the organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703) 305-1341 for after final communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

AE

January 13, 2003

Dean A. Reichard 1/27/03